Doc Code: AP.PRE.REQ

PTO/SB/33 (01-09)
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
BPCUR0007MC (C-52)

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Application Number	Filed
10/826,671	April 16, 2004

First Named Inventor
Michael Chen

Art Unit	Examiner
2421	Omar S. Parra

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☑ attorney or agent of record.
Registration number 45,432

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

/Philip H. Burrus, IV/
Signature

Philip H. Burrus, IV
Typed or printed name

404-797-8111
Telephone number

November 22, 2010
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☑ *Total of 2 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No:	10/826,671
Examiner:	Parra, Omar S.
Art Group:	2623
Reference No.:	BPCUR0007MC (C-52)
Appn. Filed:	April 16, 2004
Applicants:	Chen, Michael et al.

Title: Method and apparatus for creating a targeted integrated image

November 22, 2010

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicant hereby requests review of the final rejections to the independent claims set forth in the above-identified application. The reasons set forth below frame the issue to be considered as part of the pre-appeal review process.

Claims 1,4,5,7-11,13,18-25,27-32,37,38,41-43, and 48-52 are pending in this application. The Final Office Action rejects claims 1, 4, 5, 7-10, 13, 18-25, 27-32, 37, 38, 41-43,48-50, and 52 as being obvious in view of Plotnick et al., US Published Patent Application No. 2002/0184047, hereinafter "Plotnick," combined with O'Kane, US Published Patent Application No. 2003/0105831. Claim 11 is rejected in view of Plotnick, O'Kane, and US Published Patent Application No. 2003/0110499 to Kundson et al., hereinafter "Knudson." Claim 51 is rejected in view of Plotnick, O'Kane, and US Published Patent Application No. 2004/0030599 to Sie et al., hereinafter "Sie."

INDEPENDENT CLAIM 1:

Applicant's independent claim 1 recites, *inter alia*, the following:

- determining content previously ordered or viewed by the user and,
- in a queue of available barker advertisements,
- removing unviewed barker advertisements *corresponding to the content previously ordered or viewed by the user*.

Applicant respectfully submits that the combination of Plotnick and O'Kane fails to make known or obvious these limitations. Neither Plotnick nor O'Kane, alone or in combination, teaches a removal of barker advertisements from a queue where those barker advertisements correspond to content previously ordered by a user.

Plotnick teaches removing advertisements based upon *a predetermined number of times that they have been viewed by a user*. Plotnick states at paragraph [0061], "Once the ads have been played from the top of the queue they may be added back to the queue, either at the bottom or some other location depending on the algorithm associated with the ad and the ad queue. The ad queue may also have limitations on the *duration of time the ad is in the queue*, *the number of times the ad is played within a specific time* (or other factor), *the time frame between displaying the ads*, or some other criteria now known or later discovered that would be obvious to one of ordinary skill in the art." Similarly, at paragraph [0081], Plotnick gives other reasons ads can be removed. Plotnick states, "...UAQ is updated each time an individual ad queue needs to be updated because it is out of ads (i.e., *played maximum number of times*, *ad campaign over*, *new advertisers have purchased avails*, *existing advertisers have opted out of their avails*, or any other number of reasons that would be obvious)."

Note that none of these reasons is, as is claimed by Applicant, because the ad corresponds to previously viewed content. The Examiner specifically acknowledges this fact at page 4 of the Final Office Action, stating that Plotnick's removal process fails to teach removal of advertisements based upon correspondence to previously ordered or viewed content. The Examiner states, "Plotnick does not explicitly teach determining content previously ordered or viewed by the user and removing from a queue unviewed barker advertisements corresponding to the content previously viewed by the user." *Id.*

The Examiner submits that the addition of O'Kane to Plotnick corrects this deficiency, citing paragraphs [0075]-[0077] of O'Kane. *Id.* Applicant respectfully disagrees, at least because O'Kane teaches *the exact same removal criteria* that Plotnick does: removal based upon *a predetermined number of views*. As acknowledged by the Examiner at page 4 of the Final Office Action, this criteria fails to make known or obvious the limitations of Applicant's claim 1.

O'Kane teaches a system that uses a digital acknowledgement trigger to regulate peer-to-peer file exchange programs to "…track the actual users file use and royalty payment." O'Kane, paragraph [0035]. The viewing of an advertisement "…acts as their payment for 'proper use.'" *Id.* Said differently, "…in return for some type of payment such as viewing an advertisement…they can browse and download available content within the network, or otherwise transact with the network." O'Kane, paragraph [0038].

To this end, property owners can "…approach advertisers or partners for commercialism of the P2P networking or file sharing 'process'." O'Kane, paragraph [0060]. O'Kane's software trigger then "…allows for a process that in which commercial advertisement can also be assigned before 'delivery or download' based on the users 'preferences' that will open before the file is downloaded by the user/computer 10 and serves it's purpose." O'Kane, paragraph [0059]. A user then selects an advertisement for viewing. O'Kane, paragraph [0060].

It is clear that O'Kane does nothing to correct the deficiencies of Plotnick because O'Kane, like Plotnick, teaches removing advertisements after a predetermined number of views. At paragraph [0077], O'Kane states, with Applicant's emphasis, the following:

> The end users" MP3 or video player or file reader will assemble the "digital audio or video" file and the Commercial together. *Once the commercial is played, the software trigger, or "digital acknowledgement trigger" can be or removed by the user.* The user when the royalty is paid from the invention process then is allowed "proper use." *The end user **will only hear the commercial once per download** of that specific song or video is played.*

Applicant very respectfully submits that O'Kane therefore teaches removal for the same reason Plotnick does: based upon a predetermined number of views. In paragraph [0077] of O'Kane, which is relied upon by the Examiner, this "number of views" is 1. When the advertisement is viewed once, the payment is complete, and the advertisement can be removed. This criteria, a predetermined number of views, is exactly the same that

is set forth in Plotnick at paragraph [0081], *supra*. As noted above, the Examiner acknowledges that this criteria fails to teach Applicant's claimed limitations. See Final Office Action, page 4, *supra*. For at least this reason, the addition of O'Kane to Plotnick fails to correct the deficiency of the primary reference because O'Kane simply reiterates the removal criteria of the primary reference. Said differently, the addition of O'Kane to Plotnick simply reiterates a criteria that the Examiner acknowledges as deficient in making known or obvious Applicant's claimed limitations. For this reason, Applicant respectfully requests withdrawal of the rejection.

DEPENDENT CLAIM 11:

The Final Office Action rejects claim 11 as being unpatentable in view of Plotnick, O'Kane, and Knudson.

Applicant has shown above that the combination of Plotnick and O'Kane fails to teach removal of any barker advertisements from a queue where those advertisements correspond to previously viewed or ordered content. The addition of Knudson to Plotnick and O'Kane fails to correct this deficiency, at least for the reason that Knudson fails to teach a queue of barker advertisements at all. The resulting combination therefore suffers from the same deficiency as the base combination. Accordingly, Applicant respectfully requests withdrawal of the rejection.

DEPENDENT CLAIM 51:

Claim 51 is rejected under 35 USC §103(a) as being obvious over Plotnick and O'Kane, further in view of Sie.

Applicant is shown above that the combination of Plotnick and O'Kane fails to teach removal of any barker advertisements from a queue that correspond to previously ordered or viewed content. The addition of Sie to Plotnick and O'Kane fails to correct this deficiency.

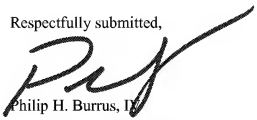
Sie, like O'Kane, fails to teach determining previously viewed content and removing barker advertisements from a queue that correspond to the previously viewed content. Sie merely teaches thwarting attempts to view commercials already inserted into, and transmitted with, content based upon a user's authorization. Such advertisements are

not barkers selected from a queue where some barkers have been removed, as is recited in Applicant's independent claims, from which claim 51 depends.

At paragraph [0132] Sie prevents users from viewing advertisements that "...appear in linearly scheduled programs or free VOD (FVOD) programs..." Sie does this, for example, where a user "...would pay for the ability to curtail or eliminate some or all advertising." Sie, paragraph [0133]. Further, when combined with Plotnick and O'Kane, the resulting combination employing Plotnick's queue and either Plotnick's or O'Kane's remval techniques teaches only the removal of already viewed advertisements as noted above. There is no reason the teaching of Sie would motivate one to do the opposite of the teachings of Plotnick or O'Kane regarding the criteria for removing advertisements from Plotnick's queue. For these reasons, Applicant respectfully requests withdrawal of the rejection.

In view of the comments above, withdrawal of the rejection is respectfully requested.

Respectfully submitted,



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